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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/696,114	10/25/2000	Toru Kobayashi	00745/LH	4404
1933	7590	10/05/2004	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC			HEWITT II, CALVIN L	
767 THIRD AVENUE			ART UNIT	PAPER NUMBER
25TH FLOOR				3621
NEW YORK, NY 10017-2023				

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/696,114	KOBAYASHI ET AL. <i>S</i>	
	<b>Examiner</b>	<b>Art Unit</b>	
	Calvin L Hewitt II	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 13 August 2004.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 124, 126-128, 130-137, 139-142, 144, 145 and 147-167 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 124, 126-128, 130-137, 139-142, 144, 145, and 147-167 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

***Status of Claims***

1. Claims 124, 126-128, 130-137, 139-142, 144, 145, and 147-167 have been examined.

***Response to Argument/Amendment***

2. The Applicant's arguments have been considered but the Examiner has found them not persuasive. Specifically, the Applicant asserts that because Freedman does not teach a "printer facility" as a "user facility" (Amendment dated 13 August 2004, pages 18 and 19) it is no longer prior art. However, the Examiner's application of the prior art is based on what is claimed. And, therefore the combined prior art of Freedman and Stefik et al. continues to read on the Applicant's **claimed system**.

Claim 124 has been amended to recite, "a user operates a print section to make a print of a document and the user operates an input section to input a print order of the user to print a copy of an ordered book". Freedman teaches a user providing (via an input section) a print specification to a printer and the printer performing an operation based on said specification. Hence, the user of the Freedman system "operates" a print section because the actions of the printer are dependent on the specification (abstract; figures 1A-2B) (note

Freedman teaches all of his system's components, user terminal, controller computer, and printer facility computer, located in a single in-house printing system- column 5, lines 23-30).

The following asserted facts have been entered into the record as prior art as they have gone unchallenged:

...consolidated billing is old and well known. For example, phone bills reflect fees and/or charges to a user by different parties or entities such as a local, long distance and international companies. Similarly, when a user uses a credit card at a POS, a first charge is calculated. This charge is transmitted back to the credit card company which then accumulates the sum of the users charges, adds other charges and presents a final charge to be paid by the user in full (American Express) or monthly (VISA, MasterCard). In either case, charges are passed up an hierarchy using an electronic network to an entity that is responsible [for] calculating a final charge.

The Examiner has applied new 112 rejections to claims 124 and 150 addressing certain discrepancies. The Rejection has been modified to address the claim amendments.

The Examiner maintains the rejection.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 124, 126-128, 130-137, 139-141, 144, and 149-167 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to

particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 150 recites a data storage section collating job IDs sent to a print service station and received from a data managing station, and specifying the print service station having the same job ID information to which the image data will be sent. However, it is not clear what ID information is associated with where "the image will be sent". Nor is it clear where is the location, "where the image will be sent".

Claims 151-165 are also rejected as they depend from claim 150.

6.
  - a. Claim 124 recites the limitation "the print service charge" in line 23. There is insufficient antecedent basis for this limitation in the claim.

Claims 126-128, 130-137, 139-145, and 147-167 are also rejected as they depend from claim 124.

- b. Claim 124 recites "the print section to print a copy of the book" in lines 18 and 19. However, the preceding "print section" is used "to make a print of a document". Therefore, there is insufficient antecedent basis for this limitation in the claim.

Claims 126-128, 130-137, 139-145, and 147-167 are also rejected as they depend from claim 124.

c. Claim 150 refers to "information transmitted from the data managing section" however, claims 149, 147, 142 and 124, from which claim 150 depends are silent regarding said feature. Claim 150 has been amended to recite the "print service station having the same job ID information to which the image data will be sent". However, claims 124, 142, 147 and 149 do not refer to where the item is sent, nor do they refer to a job ID associated with where the item is sent. Claim 151 recites similar deficiencies.

Claims 151-165 are also rejected as they depend from claims 150 and/or 151.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 124, 126-128, 130-137, 139, 140, 142, 144, 145, and 147-167 rejected under 35 U.S.C. 103(a) as being unpatentable over Freedman, U.S. Patent No. 4,839,829 in view of Stefik et al., U.S. Patent No. 6,233,684.

As per claims 124, 126-128, 130, 166 and 167 Freedman teaches a system for printing books (column 4, lines 36-42). Specifically, Freedman provides a print service station to allow customers to place and print an order (figures 1A-2B) for a fee (e.g. provides an estimate (column 10, lines 15-35 and 55-63; column 12, lines 42-50). Freedman also teaches a calculating section for calculating charges, based on a fee for using materials and/or printer (column 1, lines 30-41; column 10, lines 15-35 and 55-63; column 12, lines 42-50) and providing a user with an estimate (column 10, lines 55-62). Therefore, as the "estimate" for print services is only an approximation the actual charge may be higher, lower, or equal and the customer would be billed accordingly. Regarding the combining of the charges (claim 124), the Examiner takes Official Notice that consolidated billing is old and well known. For example, phone bills reflect fees and/or charges to a user by different parties or entities such as a local, long distance and international companies. Similarly, when a user uses a credit card at a POS, a first charge is calculated. This charge is transmitted back to the credit card company which then accumulates the sum of the users charges, adds other charges and presents a final charge to be paid by the user in full (American Express) or monthly (VISA, MasterCard). In either case, charges are passed up an hierarchy using an electronic network to an entity that is responsible calculating a final charge. However, Freedman does not specifically, teach a data service system. Stefik et al. teach a data service system, with a communication

section, connected to a network having a storage section in which a plurality of data (e.g. book data) are stored in a plurality of data storing locations and a calculating section to calculate a payment to be charged in accordance with the printing result (abstract; figures 1, 2 and 5; column 5, lines 8-10 and 35-40; column 6, lines 50-55; column 9, lines 20-60; column 13, lines 10-19). Stefik et al. also teach data service charges based on at least one of a royalty, conversion a book into an electronic form and transmitting electronic image data (figure 6; column 9, lines 20-40) and encrypting at least one of a data service or print service charge (figures 5-7). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Freedman and Stefik et al. in order provide for providing book data for a user to select from to print.

As per claims 142-156, Freedman teaches a system for requesting print services, such as services for printing letters and books (figure 1A; column 4, lines 25-43). Freedman also teaches providing customers with an estimated charge that comprises a cost summary of the different services provided by the system (column 10, lines 1-35 and 55-63; column/line 12/3-13/7) and a customer accepting the charges (column 13, lines 8-19). However, Freedman doesn't include a charge for providing book data. Stefik et al. teach charges associated with providing book data (figure 6; column 9, lines 20-40) and loan rights or "loaning" content to a user for limited time (column 5, lines 45-59). Stefik et al. also teach transmitting an order signal from customer to the data service system

and the data service system (e.g. data managing section) transmitting job ID information and image data on the basis of the job ID information (e.g. license data, work ID, watermark, rights, ...etc.) to the printer station (and storage section in order to retrieve content) in response to the order (figures 5-7; column 8, lines 25-38; column 9, lines 40-64) and transmitting a data storing location (e.g. the file, watermark) to the print section (column 8, lines 5-38). Stefik et al. also teach a method and system for determining if a user has obtained the right to print content. Therefore, the prior art at least suggest to one of ordinary skill correct identification of the printer, user and what was printed ('829, column/line 12/19-13/19; '684, figures 12 and 15).Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Freedman and Stefik et al. in order to increase revenues by providing users with access to book data ('829, column 4, lines 36-42; '684, figures 1-4 and 16; column 5, lines 7-10) and to include a charge for said access in the Freedman system's print job cost estimate ('829, column 10, lines 55-63).

As per claims 157-161 and 163, Freedman teaches a system for printing books (column 4, lines 36-42) that includes a customer logging onto a data service system, a customer being provide with then approving a print job cost estimate and the system printing a book (figure 2A; column/line 12/19-13/19). Further, as the system is only providing a customer with an "estimate" (column 10, lines 55-63; column 12, lines 19-67), it is at least obvious that if the actual

charge was higher or lower, the customer would be billed accordingly. While Stefik et al. also teach billing a user after it is verified that successful printing took place (column 13, lines 10-19). Therefore, to one of ordinary skill it would have been obvious to consider unsuccessful attempts as “trial” printing and to adjust the charge so as to not charge a user for an unsuccessful copy attempt (e.g. charging based on the printing result).

9.       Claims 141, 162 and 164 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freedman, U.S. Patent No. 4,839,829 and Stefik et al., U.S. Patent No. 6,233,684 as applied to claims 140, 160 and 163 and in further view of Yoshiura et al., U.S. Patent No. 6,131,162.

As per claims 141, 162, and 164, Freedman teaches a system for printing books (column 4, lines 36-42). Stefik et al. teach a system for secured printing of content (e.g. intellectual property, rights, fees) using cryptography and watermarks that comprises sending the content to a user and/or printer over a network (abstract; figures 1, 2 and 5-7). However, neither Freedman nor Stefik et al. explicitly recite applying a digital signature to requested data using public key or other cryptographic scheme. Yoshiura et al. disclose a general teaching of authenticating a communication using digital signatures created by a public key cryptosystem (column/line 1/25-2/58). More Specifically, Yoshiura et al. teach a system for securing data where both provider and customer systems digitally

sign data using public key cryptography (abstract; figures 2 and 5; column 6, lines 25-34; column 12, lines 12-28). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Freedman, Stefik et al. and Yoshiura et al. in order to protect against fraud and identify illegal copies of content ('684, column/line 10/1-11/23; column 12, line 10-51; '162, abstract; column 3, lines 14-28; column 11, lines 30-48).

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
c/o Technology Center 2100  
Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)

308-1113.

Calvin Loyd Hewitt II

September 23, 2004

JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600